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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/783,250

02/19/2004

Colin Watson

14824

1418

7590

09/13/2006

**SHELDON & MAK**

Suite 900

225 South Lake Avenue

Pasadena, CA 91101

EXAMINER

PETRIK, KARI KRISTEN

ART UNIT

PAPER NUMBER

3743

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/783,250	<b>Applicant(s)</b> WATSON, COLIN	
	<b>Examiner</b> Kari Petrik	<b>Art Unit</b> 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                                |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/19/2004</u> . | 6) <input type="checkbox"/> Other: ____.                                                |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the band of elastic material must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Thomas III (US Patent 6,453,903).

4. Regarding claim 1, Thomas III discloses a condom comprising an elastic, cylindrical membrane (20) having a closed end and an open end, and an elastomeric restriction ring (18) attached to the open end of the membrane adapted to fit around the base of an erect human penis to constrict the flow of blood (column 3, lines 27-30).

5. Regarding claims 2 and 3, the restriction ring may be attached to or integral with the open end of the cylindrical membrane (column 3, lines 4 and 46-50).

6. Regarding claim 4, the restriction ring is made from the group consisting of natural rubber, silicone, polyurethane, polyvinyl chloride and polyethylene (column 3, lines 40-46).

7. Regarding claim 5, the restriction ring comprises a band of elastic material (woven rubber).

8. Regarding claim 6, note the rejection of claim 2 above.

9. Regarding claim 15, the cylindrical membrane is formed from latex.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (US Patent 6,453,903) in view of Wilson III (US Patent 5,361,779).

Thomas substantially discloses the claimed invention as applied to claims 1 and 5 above, but does not disclose that the band is attached to an interior surface of the cylindrical membrane. Wilson however teaches a compression retention band applied to an interior surface of the condom (see Figures 3, 9, and 10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the condom of Thomas wherein the band is located on an interior surface of the cylindrical membrane since Wilson teaches that it is well known in the art to provide the band at different locations on the condom, and since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

12. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (US Patent 6,453,903) in view of Schwartz (US patent 5,622,186). Thomas substantially discloses the claimed invention as applied to claim 1 above, but does not disclose using a lubricant or

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spermicide. Schwartz however discloses a condom having a restriction ring and further teaches that it is well known to use spermicides. It would have been obvious to one having ordinary skill in the art at the time of the invention to have provided the condom disclosed by Thomas having a lubricant or spermicide on the outer surface, as taught by Schwartz, to further prevent against pregnancy.

13. Claims 8-13, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (US Patent 6,453,903) in view of Tsugawa (JP Application 2002-306657).

14. Regarding claims 8-10 and 13, Thomas substantially discloses the claimed invention as applied to claim 1, but does not disclose that the restriction band has knob-like protrusions about the periphery of the ring. Tsugawa however teaches a band for going around the base of a condom having knob or dome-shaped protrusions (Figures 8 and 9) in a regular circumferential array about the perimeter of the ring that may be gripped by the fingers. Therefore, it would have been *prima facie* obvious to provide the restriction ring of Thomas having protrusions, which Tsugawa teaches are known in the art, because such a modification would have been considered a mere design consideration.

15. Regarding claims 11 and 12, Thomas in view of Tsugawa do not teach the diameter of the protrusions. However, the specification provides no criticality or persuasive evidence that the diameter of the protrusions is significant. At the time the invention was made, it would have been an obvious matter of design choice to one of ordinary skill in the art to have made the protrusions about 0.15 inches in diameter or any other selected size, because Applicant has not disclosed that such a material provides an advantage, is used for a particular purpose, or solves a

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stated problem. Furthermore, Applicant suggests that the “condom can be provided with protrusions of different sizes or shapes” (p. 6, line 19). Therefore, based on the intended user, it would have obvious to one of ordinary skill in the art to arrive at the claimed dimensions because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art.

16. Regarding claims 16, 17, and 18, note the rejection of claims 8-10 above.

17. Regarding claim 19, note the rejection of claim 11.

18. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (US Patent 6,453,903) in view of Tsugawa (JP Application 2002-306657) in further view of Schwartz (US Patent 5,622,186).

19. Thomas in view of Tsugawa substantially discloses the claimed invention as applied to claims 8 and 16, but does not teach using a lubricant or spermicide on the outer surface of the condom. Schwartz however discloses a condom having a restriction ring and further teaches that it is well known to use spermicides. It would have been obvious to one having ordinary skill in the art at the time of the invention to have provided the condom disclosed by Thomas in view of Tsugawa having a lubricant or spermicide on the outer surface, as taught by Schwartz, to further prevent against pregnancy.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kari Petrik whose telephone number is 571-272-8057. The examiner can normally be reached on M-Th and every other Friday, 7-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KKP

Kari Petrik  
Examiner  
Art Unit 3743

Henry Bennett  
Supervisory Patent Examiner  
Group 3700